

REMARKS

In the application claims 1-57 and 86-107 remain pending. Claims 58-85 have been canceled without prejudice. Certain of the claims have been amended to clarify what is regarded as the invention. The amendments find their support in the specification, figures, and claims as originally filed and, as such, no new matter has been added.

All of pending claims presently stand rejected. The reconsideration of the rejection of the claims is, however, respectfully requested.

In the latest Office Action, the pending claims were generally rejected under 35 U.S.C. § 103 as being rendered obvious by Blight (U.S. Patent No. 6,785,542) as modified by Helot (U.S. Patent No. 6,309,230) as further modified by Moreland (U.S. Patent No. 6,000,807). In rejecting the claims, the Office Action acknowledged that Blight does not disclose the feature of a wall switch device or power switch device fastened to a wall switch module or power module, respectively. As to Helot, the Office Action asserted that Helot discloses a docking station that, among other things, includes a power cord that is connected to a power switch, e.g., a wall socket. As to Moreland, the Office Action asserted that Moreland discloses a circuit in a switch plate. Thus, based upon these disclosures, the Office Action concluded that it would have been obvious to apply the technique of Moreland to the modified system of Helot and Blight in order to provide a circuit within a switch plate that is mounted over a switch box by the typical screw-on method used for common switch plates.

In response to this rejection of the claims, it is respectfully submitted that a rejection under 35 U.S.C. § 103 requires that a combination of references disclose each

and every element set forth in the claims, considering the claims “as a whole.” This requirement that the claimed invention be considered “as a whole” is meant to prevent evaluation of an invention part by part, i.e., breaking an invention into its component parts and then merely finding a reference containing one part, another reference containing another part, etc., and to prevent the impermissible use of the specification of the applicant as a template to combine these parts for the purpose of deprecating the claimed invention. Thus, to assure that such “hindsight reasoning” is not used when assessing the patentability of a claimed invention, a rejection under 35 U.S.C. § 103 requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have selected the various parts from the references and combined them in the claimed manner. Furthermore, it is impermissible to pick and choose from a reference only so much as will support a given position while disregarding what such reference teaches in its entirety.

Considering now the rejection of the claims, it is respectfully noted that the Office Action fails to present a *prima facie* case of obviousness and, for this reason, the rejection of the claims must be withdrawn. While the Office Action does set forth what is allegedly disclosed in each of Blight and Helot, the Office Action not only fails to set forth any rationale as to why one of ordinary skill in the art might select certain elements from Helot for the purpose of modifying Blight but even fails to describe what is included within “the modified system of Helot and Blight.” Therefore, by failing to present at least a convincing line of reasoning as to why one of ordinary skill in the art might use the disclosure of Helot to modify Blight to arrive at “the modified system of Helot and Blight,” whatever that system might include, the Office Action fails to meet the

initial burden of proving that the claimed invention is directed to obvious subject matter. For this reason the rejection of the claims must be withdrawn.

Still further, it is respectfully submitted that the teachings within Moreland are insufficient to present a *prima facie* case of obviousness. In this regard, while Moreland may disclose a circuit within a switch plate as asserted in the Office Action, nothing from within Moreland discloses, teaches, or suggests the desirability of placing a communication circuit, as is claimed, within a switch plate that is mounted over a switch box. At best, Moreland only teaches the desirability of including an emergency lighting circuit within a switch plate. Thus, since Moreland fails to disclose the desirability of modifying either Blight or Helot to relocate their communication circuitry to a switch plate, the teachings within Moreland cannot be said to demonstrate that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have utilized the teaching from Moreland to arrive at the invention claimed. For this reason the rejection of the claims must be withdrawn.

It is additionally noted that the Moreland specifically teaches that his invention provides no physical or electrical interconnection between the circuit within the switch plate and any AC device or wiring. Accordingly, if one of ordinary skill in the art were to follow the teachings set forth within Moreland, as has been espoused in the Office Action, one of ordinary skill in the art would be led directly away from the invention claimed which sets forth that the circuitry of the switch plate is electrically coupled to power wires fed into the junction box to thereby allow for the powering of the circuitry by the power wires and/or the use of the power wires to enable communication between the wall switch device and the network. Thus, since Moreland teaches directly against

the invention claimed, the teachings within Moreland cannot be said to support a *prima facie* case of obviousness. For this reason the rejection of the claims must be withdrawn.

Yet further, it is respectfully submitted that Moreland discloses that it is a “key” aspect of his invention to provide a switch plate wherein the circuit components and their supporting elements are not visible from the front of the switch plate, i.e., the circuit components are inaccessible from the front of the switch plate. Accordingly, it is respectfully submitted that, were one of ordinary skill in the art to follow the express teachings of Moreland and modify either Blight or Helot in the manner suggested in the Office Action, the resulting system would render the systems of Blight or Helot inoperable, i.e., the “modified system” espoused in the Office Action would not allow the handheld devices of either Blight or Helot to interface with any circuit housed within a switch plate since, according to Moreland, it is desired that such circuits be inaccessible from the front of the switch plate. As it is impermissible to suggest a modification that would render Blight and Helot inoperable or which would change the principles of operation of Blight or Helot, the teachings of the references are not sufficient to render the claims *prima facie* obvious. For this reason the rejection of the claims must be withdrawn.

CONCLUSION

The subject application is considered to be in condition for allowance. Such action on the part of the Examiner is respectfully requested. Should it be determined, however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

The Commissioner is hereby authorized to charge any fee deficiency or credit overpayment to deposit account number 50-2428 in the name of Greenberg Traurig.

Respectfully Submitted

Date: May 18, 2005

By: 

Gary R. Jarosik
Reg. No. 35,906
Greenberg Traurig LLP
77 W. Wacker Drive, Suite 2500
Chicago, Illinois 60601
(312) 456-8449